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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,875	10/30/2003	Tomoaki Hoshino	032079	6666
38834	7590	11/17/2004	EXAMINER	
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036			CHAUDHURI, ANIRUDDHO RAY	
			ART UNIT	PAPER NUMBER
			1644	

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/695,875

Applicant(s)

HOSHINO ET AL.

Examiner

Aniruddho R Chaudhuri

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/07/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 1-6, 10 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 7-9 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The Art Unit and the examiner of this application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Aniruddho Ray Chaudhuri, Group Art Unit 1644, Technology Center 1600.
2. Applicant's election without traverse, of Claims 7-9 (Group II), drawn to an agent for preventing or treating dermatitis and/or alopecia, in the reply filed on 10/07/2004 is acknowledged.

Claims 1-6, 10-11 (non-elected groups I and III) are withdrawn from further consideration under, 37 C.F.R. § 1.142(b) as being drawn to nonelected inventions.

Claims 7 - 9, are under consideration in the instant application.

3. The following is noted: Claims 7-9 include a recitation of "an agent comprising a substance that suppresses a cell". These various agents encompass antibodies as claimed, immunosuppressants, inhibitors of molecules (see pages 10 -11 of the specification). These agents differ in structure and modes of action and have non-coextensive searches of such an extent that they are considered separately patentable. Therefore, the restriction will be set forth for each of the various groups, irrespective of the format of the claims.

Election/Restrictions

4. Restriction to one of the following inventions is required under 35 U.S.C. § 121:
 - I. Claims 7-9, drawn to an agent, that reads on using anti-NK cell antibodies, classified in Class 530, subclass 387.1 and Class 424, subclass 130.1.
 - II. Claims 7-9, drawn to an agent, that reads on using anti-NKT cell antibodies, classified in Class 530, subclass 387.9 and Class 424, subclass 134.1.
 - III. Claims 7-9, drawn to an agent, that reads on using soluble HLA-class I proteins, classified in Class 530, subclass 300 and Class 514, subclass 2.
 - IV. Claims 7-9, drawn to an agent, comprising an agent that reads on using FK 506, classified in Class 530, subclass 350 and Class 514, subclass 4.
 - V. Claims 7-9, drawn to an agent, that reads on using DAP12, classified in Class 530, subclass 350 and Class 514, subclass 8.
 - VI. Claims 7-9, drawn to an agent, that reads on using SHP, classified in Class 530, subclass 352 and Class 514, subclass 8.

- VII. Claims 7-9, drawn to an agent, that reads on using anti-asialo GM1 antibodies, classified in Class 530, subclass 387.7 and Class 424, subclass 130.1.
- VII. Claims 7-9, drawn to an agent, that reads on using anti-killer inhibitory receptor antibodies, classified in Class 530, subclass 388.22 and Class 424, subclass 143.1.
- VIII. Claims 7-9, drawn to an agent, that reads on using antibodies that activate NK cells, classified in Class 530, subclass 388.73 and Class 424, subclass 152.1.
- IX. Claims 7-9, drawn to an agent, that reads on using antibodies such as anti-Ly49D antibodies, classified in Class 530, subclass 388.26 and Class 424, subclass 144.1.

5. Groups I - IX are different products. They are distinct because their structures and/or modes of action are different. Therefore, the inventions are patentably distinct.

These inventions are distinct for the reasons given above. In addition, they have acquired a separate status in the art as shown by different classification and/or recognized divergent subject matter. They also do not share *a substantial structural feature essential to a common utility*. Further, even though in some cases the classification is shared, a different field of search would be required based upon the structurally distinct products recited. Moreover, a prior art search also requires a literature search. It is an undue burden for an examiner to search more than one invention. Therefore restriction for examination purposes as indicated is proper.

6. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Art Unit: 1644

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aniruddho Ray Chaudhuri whose telephone number is 571-272-0953. The examiner can normally be reached on Monday thru Friday 8:30 - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on 571-272-0841. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aniruddho Ray Chaudhuri (AC), Ph.D.
Patent Examiner
Technology Center 1600
November 12, 2004

Phillip Gambel
PHILLIP GAMBEL, PH.D.
PRIMARY EXAMINER
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11/12/04